



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

*Am*

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/732,791	12/11/2000	Yueh-O Yu	EM/YU/6285	2738

7590 06/28/2005  
BACON & THOMAS, PLLC  
625 Slaters Lane, 4th Floor  
Alexandria, VA 22314-1176

EXAMINER

LAZARO, DAVID R

ART UNIT PAPER NUMBER

2155

DATE MAILED: 06/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/732,791

Applicant(s)

YU ET AL

Examiner

David Lazaro

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7, 20-33, 35, 40-49, 52-60, 69-71, 73-76 and 78-83 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 20-33, 35, 40-49, 52-60, 69-71, 73-76, 78-83 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. This office action is in response to the RCE filed 05/24/05.
2. Claims 1-3, 20, 21, 33, 35, 40, 52, 63 and 69-71 were amended.
3. Claims 18, 19, 34, 36-39, 50, 51, 61, 62, 64, 65, 67, 68 and 72 are canceled.
4. Claims 1-7, 20-33, 35, 40-49, 52-60, 69-71, 73-76, 78-83 are pending in this office action.

### ***Claim Objections***

5. Claim 1 is objected to because of the following informalities: In lines 3-4, the phrase "as detecting" would be more clear as "upon detecting". Appropriate correction is required.
6. Claim 20 is objected to because of the following informalities: In line 4, "an" should just be "a". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:  
  
The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
8. Claim 20 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one

Art Unit: 2155

skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 20 includes the following limitations:

**“filtering said transmission signal; and transforming said transmission signal into an identification information if said transmission signal corresponds with predetermined deletion conditions”** (emphasis added). The emphasized subject matter above is not described in the specification. Descriptions of the “filtering” element/embodiments are given on pages 7, 8, 11, 12 of the specification. However, the descriptions on these pages do not describe filtering of transmission signals or determinations of if a transmission signal corresponds with predetermined deletion conditions. These pages at best, describe filtering of identification information or the electronic mail, but not filtering of transmission signals nor transmission signals corresponding with predetermined deletion conditions. Because of this, Claim 20 fails to comply with the written description requirement.

9. Claim 52 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 52 includes the limitation “and a filtering device for **suspending said transmission signal corresponding with a plurality of set deletion conditions prior to transferring said transmission signal**”.

Descriptions of the “filtering” element/embodiments are given on pages 7, 8, 11, 12 of

Art Unit: 2155

the specification. However, the descriptions on these pages do not describe filtering of transmission signals. More specifically, no description is given in regards to transmission signals corresponding with a plurality of set deletion conditions such that the transmission signal is suspended. Because of this, Claim 52 fails to comply with the written description requirement.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1, 2, 5-12, 15, 16, 20-27, 30, 31, 33, 35, 40-47, 52-58, 63, 66 and 70 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,212,265 by Duphorne (Duphorne).

12. With respect to Claim 1, Duphorne teaches a method for actively providing users with the message concerning new mail, carried out by an electronic mail provider (Col. 2 lines 18-22 and Col. 3 line 60 - Col. 4 line 31), said method comprising: creating identification information of said new mail as detecting said new mail by an electronic mail provider (Col. 2 lines 21-35 and Col. 3 line 60 - Col. 4 line 31); filtering said identification information (Col. 4 lines 32-47 and Col. 5 lines 1-7); transforming said

Art Unit: 2155

identification information into a transmission signal (Col. 2 lines 21-35) if said identification information corresponds with predetermined deletion conditions (Col. 4 lines 32-47 and Col. 5 lines 1-7); and transferring said transmission signal to a non-portable receiving terminal (Col. 2 lines 21-35).

13. With respect to Claim 2, Duphorne teaches all the limitations of Claim 1 and further teaches a step of automatically sending said identification information of said new mail to said non-portable receiving terminal after receiving a response from said non-portable receiving terminal (Col. 6 line 55 – Col. 7 line 11).

14. With respect to Claim 5, Duphorne teaches all the limitations of Claim 1 and further teaches a step of receiving said new mail by said users from said electronic mail provider through a telecommunication network after said users receiving said identification information (Col. 11 lines 2-4).

15. With respect to Claim 6, Duphorne teaches all the limitations of Claim 1 and further teaches said electronic mail provider transfers said transmission signal during a specific period (Col. 4 lines 40-47).

16. With respect to Claim 7, Duphorne teaches all the limitations of Claim 1 and further teaches said transmission signal further comprises advertisement information of said electronic mail provider (Col. 9 lines 31-67).

17. With respect to Claim 8, Duphorne teaches all the limitations of Claim 1 and further teaches said electronic mail provider transforms said identification information into said transmission signal and transfers said transmission signal by using an identification communication protocol for a caller terminal (Col. 6 lines 10-54).

18. With respect to Claim 9, Duphorne teaches all the limitations of Claim 1 and further teaches said identification information comprises a message subject for said new mail (Col. 4 lines 65-67).

19. With respect to Claim 10, Duphorne teaches all the limitations of Claim 1 and further teaches said identification information comprises a receiving date and a receiving time (Col. 4 lines 65-67).

20. With respect to Claim 11, Duphorne teaches all the limitations of Claim 1 and further teaches said identification information comprises an electronic mail address of a sender (Col. 8 lines 28-33).

21. With respect to Claim 12, Duphorne teaches all the limitations of Claim 1 and further teaches said identification information comprises a name of a sender (Col. 8 lines 28-33).

22. With respect to Claim 15, Duphorne teaches all the limitations of Claim 1 and further teaches said transmission signal is in a frequency shift key format (Col. 6 lines 48-50).

23. With respect to Claim 16, Duphorne teaches all the limitations of Claim 1 and further teaches said transmission signal is in a dual-tone multi-frequency format (Col. 6 lines 48-50).

24. With respect to Claim 20, Duphorne teaches a method for obtaining a message a new electronic mail (Col. 2 lines 18-22), said method comprising: receiving a transmission signal actively transferred from an electronic mail provider through a non-portable receiving terminal (Col. 2 lines 21-35); filtering said transmission signal (Col. 4

lines 32-47 and Col. 5 lines 1-7); and transforming said transmission signal into identification information (Col. 8 lines 8-41) if said transmission signal corresponds with predetermined deletion conditions (Col. 4 lines 32-47 and Col. 5 lines 1-7), said identification information being related to said new electronic mail that is not yet received or read by users (Col. 4 lines 10-31).

25. With respect to Claim 21, Duphorne teaches all the limitations of Claim 20 and further teaches automatically transferring a response from said receiving terminal to said electronic mail provider after receiving said transmission signal, and said step of automatically transferring used for requesting said electronic mail provider to automatically transfer said identification information to said non-portable receiving terminal (Col. 6 line 55 – Col. 7 line 11).

26. With respect to Claim 22, Duphorne teaches all the limitations of Claim 20 and further teaches a step of displaying said identification information for notifying said users (Col. 8 lines 24-33).

27. With respect to Claim 23, Duphorne teaches all the limitations of Claim 20 and further teaches a step of receiving said electronic mail from said electronic mail provider through a telecommunication network after reading said identification information by said users (Col. 11 lines 2-4).

28. With respect to Claim 24, Duphorne teaches all the limitations of Claim 20 and further teaches said identification information comprises a message subject for said electronic mail (Col. 8 lines 28-33).



Art Unit: 2155

29. With respect to Claim 25, Duphorne teaches all the limitations of Claim 20 and further teaches said identification information comprises a receiving date and a receiving time (Col. 8 lines 28-33).

30. With respect to Claim 26, Duphorne teaches all the limitations of Claim 20 and further teaches said identification information comprises an electronic mail address of a sender. (Col. 8 lines 28-33).

31. With respect to Claim 27, Duphorne teaches all the limitations of Claim 20 and further teaches said identification information comprises a name of a sender (Col. 8 lines 28-33).

32. With respect to Claim 30, Duphorne teaches all the limitations of Claim 20 and further teaches said transmission signal is in a frequency shift key format (Col. 6 lines 48-50).

33. With respect to Claim 31, Duphorne teaches all the limitations of Claim 20 and further teaches said transmission signal is in a dual-tone multi-frequency format (Col. 6 lines 48-50).

34. With respect to Claim 33, Duphorne teaches all the limitations of Claim 20 and further teaches said receiving terminal comprises an electronic mail identification phone (Col. 7 lines 11-26).

35. With respect to Claim 35, Duphorne teaches all the limitations of Claim 20 and further teaches said receiving terminal comprises a caller identification phone that has electronic mail identification function (Col. 7 lines 11-26 and Col. 8 lines 37-41).

36. With respect to Claim 40, Duphorne teaches a system for actively transferring identification information of an electronic mail (Col. 2 lines 18-35), said system comprising: modulating means for transforming said identification information into a transmission signal (Col. 6 lines 44-56); and transferring means for transferring said transmission signal to a receiving terminal of a user (Col. 6 lines 44-56); and a filtering device, wherein said filtering device stops transforming identification information into said transmission signal if the electronic mail corresponds with predetermined delete conditions (Col. 4 lines 32-47 and Col. 5 lines 1-7), said filtering device transforms said identification information into said transmission signal if the electronic mail corresponds with said predetermined permission conditions (Col. 4 lines 32-47 and Col. 5 lines 1-7).

37. With respect to Claim 41, Duphorne teaches all the limitations of Claim 40 and further teaches a mail server which is set in said electronic mail provider, wherein said mail server is used for receiving and transferring said electronic mails (Col. 3 lines 60-66).

38. With respect to Claim 42, Duphorne teaches all the limitations of Claim 40 and further teaches said electronic mail provider transforms said identification information into said transmission signal and transfers said transmission signal by utilizing an communication protocol of identification service by a caller terminal (Col. 6 lines 44-56).

39. With respect to Claim 43, Duphorne teaches all the limitations of Claim 40 and further teaches said electronic mail provider transfers said transmission signal during a specific period (Col. 4 lines 40-47).

Art Unit: 2155

40. With respect to Claim 44, Duphorne teaches all the limitations of Claim 40 and further teaches said identification information comprises a message subject for said electronic mail (Col. 4 lines 65-67).

41. With respect to Claim 45, Duphorne teaches all the limitations of Claim 40 and further teaches said identification information comprises a date and a time (Col. 4 lines 65-67).

42. With respect to Claim 46, Duphorne teaches all the limitations of Claim 40 and further teaches said identification information comprises a sender's electronic mail address (Col. 8 lines 28-33).

43. With respect to Claim 47, Duphorne teaches all the limitations of Claim 40 and further teaches said identification information comprises a sender's name (Col. 8 lines 28-33).

44. With respect to Claim 52, Duphorne teaches a system for assisting a user in acquiring a message concerning new electronic mail (Col. 2 lines 18-35), said system comprising: non-portable receiving means for receiving a transmission signal which is transferred from an electronic mail provider (Col. 7 lines 11-20); analyzing means for transforming said transmission signals into an identification information of said new electronic mail (Col. 8 lines 8-28); displaying means for displaying said identification information (Col. 7 lines 48-57); and a filtering device for suspending said transmission signal corresponding with a plurality of set deletion conditions prior to transferring said transmission signal (Col. 4 lines 32-47 and Col. 5 lines 1-7).

Art Unit: 2155

45. With respect to Claim 53, Duphorne teaches all the limitations of Claim 52 and further teaches a storage device for storing said identification information (Col. 8 lines 15-20).

46. With respect to Claim 54, Duphorne teaches all the limitations of Claim 52 and further teaches said electronic mail provider translates said identification information and transfers said transmission signal by utilizing an communication protocol of identification service by a caller terminal (Col. 6 lines 44-56).

47. With respect to Claim 55, Duphorne teaches all the limitations of Claim 52 and further teaches said identification information comprises a message subject for said new electronic mail (Col. 4 lines 65-67).

48. With respect to Claim 56, Duphorne teaches all the limitations of Claim 52 and further teaches said identification information comprises a date and a time (Col. 4 lines 65-67).

49. With respect to Claim 57, Duphorne teaches all the limitations of Claim 52 and further teaches said identification information comprises a sender's electronic mail address (Col. 8 lines 28-33).

50. With respect to Claim 58, Duphorne teaches all the limitations of Claim 52 and further teaches said identification information comprises a sender's name (Col. 8 lines 28-33).

51. With respect to Claim 63, Duphorne teaches all the limitations of Claim 52 and further teaches said non-portable receiving means comprises an identification phone of

a caller terminal which has electronic mail identification function (Col. 7 lines 11-26 and Col. 8 lines 37-41).

52. With respect to Claim 66, Duphorne teaches all the limitations of Claim 52 and further teaches said displaying means comprises an audio broadcasting device (Col. 7 lines 48-60).

53. With respect to Claim 70, Duphorne teaches all the limitations of Claim 52 and further teaches further teaches a connecting device for connecting said receiving terminal and electronic mail provider when said transmission signal is received (Col. 7 lines 11-26).

***Claim Rejections - 35 USC § 103***

54. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

55. Claims 3, 4, 13, 14, 28, 29, 48, 49, 59, 60, 71 and 73-83 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duphorne in view of U.S. Patent 5,933,478 by Ozaki et al. (Ozaki).

56. With respect to Claim 3, Duphorne teaches all the limitations of Claim 1 and but does not explicitly disclose suspending a connection between the mail provider and non-portable receiving terminal. Ozaki teaches a similar method of providing to a user a message concerning a new electronic mail (Col. 10 line 58 - Col. 11 line 12). Ozaki

teaches that a connection between electronic mail provider and the receiving terminal is suspended by detecting a first deadline of establishing said connection (Col. 12 lines 40-56). It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Duphorne and modify it as indicated by Ozaki such that the method further comprises a step of suspending a connection between said electronic mail provider and said non-portable receiving terminal. One would be motivated to have this as it insures a user will receive notification of important newly received information (Col. 2 lines 4-28 of Ozaki).

57. With respect to Claim 4, Duphorne in view of Ozaki teaches all the limitations of Claim 3 and further teaches a step of re-establishing said connection and thereafter transferring said transmission signal (Col. 12 lines 40-56 of Ozaki).

58. With respect to Claim 13, Duphorne teaches all the limitations of Claim 1 but does not explicitly disclose identification information comprising a distinctive code. Ozaki teaches identification information comprising a distinctive code (Col. 9 lines 23-30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Duphorne and modify it as indicated by Ozaki such that the identification information comprises a distinctive code. One would be motivated to have this as it helps give a user immediate access to newly received information (Col. 2 lines 15-19 and 40-44 of Ozaki).

59. With respect to Claim 14, Duphorne in view of Ozaki teaches all the limitations of Claim 13 and further teaches said distinctive code comprises a telephone number of said electronic mail provider (Col. 9 lines 23-30 of Ozaki).

Art Unit: 2155

60. With respect to Claim 28, Duphorne teaches all the limitations of Claim 20 but does not explicitly disclose identification information comprising a distinctive code. Ozaki teaches identification information comprising a distinctive code (Col. 9 lines 23-30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Duphorne and modify it as indicated by Ozaki such that the identification information comprises a distinctive code. One would be motivated to have this as it helps give a user immediate access to newly received information (Col. 2 lines 15-19 and 40-44 of Ozaki).

61. With respect to Claim 29, Duphorne in view of Ozaki teaches all the limitations of Claim 28 and further teaches said distinctive code comprises a telephone number of said electronic mail provider (Col. 9 lines 23-30 of Ozaki).

62. With respect to Claim 48, Duphorne teaches all the limitations of Claim 40 but does not explicitly disclose identification information comprising a distinctive code. Ozaki teaches identification information comprising a distinctive code (Col. 9 lines 23-30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the system disclosed by Duphorne and modify it as indicated by Ozaki such that the identification information comprises a distinctive code. One would be motivated to have this as it helps give a user immediate access to newly received information (Col. 2 lines 15-19 and 40-44 of Ozaki).

63. With respect to Claim 49, Duphorne in view of Ozaki teaches all the limitations of Claim 48 and further teaches said distinctive code comprises a telephone number of said electronic mail provider (Col. 9 lines 23-30 of Ozaki).

64. With respect to Claim 59, Duphorne teaches all the limitations of Claim 52 but does not explicitly disclose identification information comprising a distinctive code. Ozaki teaches identification information comprising a distinctive code (Col. 9 lines 23-30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the system disclosed by Duphorne and modify it as indicated by Ozaki such that the identification information comprises a distinctive code. One would be motivated to have this as it helps give a user immediate access to newly received information (Col. 2 lines 15-19 and 40-44 of Ozaki).

65. With respect to Claim 60, Duphorne in view of Ozaki teaches all the limitations of Claim 59 and further teaches said distinctive code comprises a telephone number of said electronic mail provider (Col. 9 lines 23-30 of Ozaki).

66. With respect to Claim 71, Duphorne teaches a method for transferring an identification information of an electronic mail (Col. 2 lines 18-35), said method comprising: transferring said identification information from an electronic mail provider to a receiving terminal which is predetermined by a corresponding user of said electronic mail (Col. 4 lines 20-31); transferring an identification information of said electronic mail to said receiving terminal when a response message from said receiving terminal is received within a predetermined period (Col. 4 lines 20-31). Duphorne does not explicitly disclose suspending a connection if no response is received after a predetermined period and re-establishing said connection between said electronic mail provider and said receiving terminal after suspending said connection and thereafter waiting a standby period. Ozaki teaches that a connection between electronic mail



Art Unit: 2155

provider and the receiving terminal is suspended when no response is received after a predetermined period (Col. 12 lines 40-56). Ozaki further teaches reestablishing said connection between said electronic mail provider and said receiving terminal after suspending said connection and thereafter waiting a standby period (Col. 12 lines 40-56). It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Duphorne and modify it as indicated by Ozaki such that the method further comprises suspending a connection between said electronic mail provider and said receiving terminal when no said response message is received within said predetermined period; and re-establishing said connection between said electronic mail provider and said receiving terminal after suspending said connection and thereafter waiting a standby period. One would be motivated to have this as it insures a user will receive notification of important newly received information (Col. 2 lines 4-28 of Ozaki).

67. With respect to Claim 73, Duphorne in view of Ozaki teaches all the limitations of Claim 71 and further teaches a step of connecting to said electronic mail provider for getting said electronic mail after receiving said identification information (Col. 7 lines 27-29 of Duphorne).

68. With respect to Claim 74, Duphorne in view of Ozaki teaches all the limitations of Claim 71 and further teaches a step of storing said identification information on said receiving terminal for displaying when said user queries (Col. 8 lines 8-28 of Duphorne).

Art Unit: 2155

69. With respect to Claim 75, Duphorne in view of Ozaki teaches all the limitations of Claim 71 and further teaches said electronic mail provider transfers said transmission signal during a specific period (Col. 4 lines 40-47 of Duphorne).

70. With respect to Claim 76, Duphorne in view of Ozaki teaches all the limitations of Claim 71 and further teaches said identification information comprises a message subject for said electronic mail (Col. 4 lines 65-67 of Duphorne).

71. With respect to Claim 77, Duphorne in view of Ozaki teaches all the limitations of Claim 71 and further teaches said identification information comprises a date and a time (Col. 4 lines 65-67 of Duphorne).

72. With respect to Claim 78, Duphorne in view of Ozaki teaches all the limitations of Claim 71 and further teaches said identification information comprises a sender's electronic mail address (Col. 8 lines 28-33 of Duphorne).

73. With respect to Claim 79, Duphorne in view of Ozaki teaches all the limitations of Claim 71 and further teaches said identification information comprises a sender's name (Col. 8 lines 28-33 of Duphorne).

74. With respect to Claim 80, Duphorne in view of Ozaki teaches all the limitations of Claim 71 and further teaches said identification information comprises a distinctive code (Col. 9 lines 23-30 of Ozaki).

75. With respect to Claim 81, Duphorne in view of Ozaki teaches all the limitations of Claim 80 and further teaches said distinctive code comprises a telephone number of said electronic mail provider (Col. 9 lines 23-30 of Ozaki).

76. With respect to Claim 82, Duphorne in view of Ozaki teaches all the limitations of Claim 71 and further teaches hardware of said receiving terminal has a caller identification function (Col. 8 line 38-41 of Duphorne).

77. With respect to Claim 83, Duphorne in view of Ozaki teaches all the limitations of Claim 71 and further teaches said receiving terminal further comprises a connecting device for establishing a connection between said receiving terminal and said electronic mail provider (Col. 7 lines 11-26).

78. Claims 17 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duphorne in view of U.S. Patent 5,875,234 by Clayton et al. (Clayton).

79. With respect to Claim 17, Duphorne teaches all the limitations of Claim 1. Although Duphorne teaches the transmission format is of an appropriate format for the email notification device according to Caller ID protocols (Col. 6 lines 44-47), Duphorne does not explicitly disclose the transmission signal is in a universal asynchronous receive and transmission (UART) format. Clayton teaches that the UART format is typically used for Caller ID services (Col. 9 lines 52-53). It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Duphorne and modify it as indicated by Ozaki such that said transmission signal is in a UART format. One would be motivated to have this as it can be easily integrated with existing protocols and infrastructure (Col. 2 lines 22-34 of Duphorne).

80. With respect to Claim 32, Duphorne teaches all the limitations of Claim 20. Although Duphorne teaches the transmission format is of an appropriate format for the

Art Unit: 2155

email notification device according to Caller ID protocols (Col. 6 lines 44-47), Duphorne does not explicitly disclose the transmission signal is in a universal asynchronous receive and transmission (UART) format. Clayton teaches that the UART format is typically used for Caller ID services (Col. 9 lines 52-53). It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Duphorne and modify it as indicated by Ozaki such that said transmission signal is in a UART format. One would be motivated to have this as it can be easily integrated with existing protocols and infrastructure (Col. 2 lines 22-34 of Duphorne).

81. Claim 69 is rejected under 35 U.S.C. 103(a) as being unpatentable over Duphorne in view of U.S. Patent Application Publication 2001/0012286 by Huna et al. (Huna).

82. With respect to Claim 69, Duphorne teaches all the limitations of Claim 20 but does not explicitly disclose a switch device for controlling operation of the non-portable receiving means. Huna teaches a switch device for controlling the receiving means such that transmission signals concerning new email are received when it is on and not received when it is off (Page 6 [0071]). It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the system disclosed by Duphorne and modify it as indicated by Huna such that there is a switch device for controlling operation of said non-portable receiving means, said non-portable receiving means receiving said transmission signal when said switch device is on, and said receiving terminal stopping receiving said transmission signal when said switch device

is off. One would be motivated to have this as it is desirable to allow the user to configure the notification system according to their current preference (Page 6 [0071]).

### ***Response to Arguments***

83. Applicant's arguments filed 05/24/05 have been fully considered but they are not persuasive.

84. Applicants argue on page 14 of the remarks - "*The system of Duphorne queries the user's ISP email server to determine whether any email addressed to the user is received by and/or stored thereon. The ISP email server 16a receives a query signal from a query software maintained by a central office 14 first or an information service provider so as to transmit a preliminary email notification signal in respond to the query signal.*"

a. The examiner respectfully disagrees with applicants' interpretation of Duphorne. As stated repeatedly in the "Response to arguments' section of the previous office action (mailed 9/7/04), the system of Duphorne does not necessarily query the user's ISP email server. The system includes automatic notification by the email server to the central office upon the arrival of a new email (Col. 4 lines 10-14). Furthermore, the central office may itself contain and maintain the users email server as described in Col. 3 lines 27-34, and Col. 3 line 66- Col. 4 line 20.

85. Applicants argue on page 14 of the remarks - "*In contrast, the system of the claimed invention includes a filter device to stop transforming the identification information into the transmission signal if the electronic mail corresponds with some*

*predetermined delete conditions, and to transform the identification information into a transmission signal if the electronic mail corresponds with some predetermined permission conditions."*

b. The examiner notes that the claim language of claims 1 and 20 seem to convey the opposite of what applicants are asserting. The examiner respectfully requests the applicants review the claim language to insure the subject matter is presented as desired.

86. Applicants argue on page 15 of the remarks - "*...the method of Duphorne does not include or require a step of filtering the preliminary email notification signal before transforming it to a Caller ID-compatible email notification signal, and a step of transforming the preliminary email notification signal into a Caller ID-compatible email notification signal only if the preliminary email notification signal corresponds with predetermined deletion conditions.*"

c. Duphorne does teach a step of filtering through the use of a user notification parameter database (Col. 4 lines 32-47). The database is used for "spam filtering information, and/or other filtering information such as, for instance, particular usernames and/or domain names from which the user does not wish to receive email notification" (Col. 4 lines 40-47). Col. 5, lines 1-7 further describes examples of filtering based on email sources, email subject or content, as well as filtering based on any additional information as desired. Such filtering information can either permit or deny the transmission of the notification to the receiving terminal (Col. 4 lines 40-47 and Col. 5 lines 1-7). The examiner considers this to be within the scope of the claimed subject matter.

87. Applicants argue on page 15 of the remarks *"Duphorne does not even remotely suggest such a suspending step and adjustable set and standby periods."*

d. Applicants have not specifically pointed out what claim language they are attempting to distinguish from the teachings of Duphorne in terms of the 102(e) rejections. None of the claims rejected under 102(e) as being anticipated by Duphorne, suggest that Duphorne teaches this subject matter. In fact, the rejection of claim 3 makes note of the fact that Duphorne "does not explicitly disclose suspending a connection between the mail provider and non-portable receiving terminal" (See Paragraph 56 in this office action). This subject matter has been addressed on the basis of the combination of Duphorne in view of Ozaki (as in claim 3, for example).

88. Applicants argue on page 16 of the remarks *"This rejection is again respectfully traversed on the grounds that the Ozaki patent, like the Duphorne patent, neither discloses nor suggests an ISP email server that transforms e-mail identification information provided by an electronic mail provider into a transmission signal to be transferred to a non-portable receiving terminal, as claimed ...there is no suggestion or teaching that would have suggested modification of the system and method of Duphorne to transform identification information in the manner claimed. Instead, as noted above, Duphorne specifically teaches that querying the user's ISP email server to determine whether any email addressed to the user is received by and/or stored thereon."*

e. Applicants do not provide specific evidence, reasoning, or errors in the examiner's rejection as to how any specific claim language is distinguished from the teachings of Duphorne as well as the teachings of the combination of

Duphorne and Ozaki. Applicants merely make a conclusive statement without describing the significance of their interpretation of either the Duphorne or Ozaki reference in comparison to the claimed subject matter. Applicants do not even refer to the specific claim language they are attempting to distinguish over the cited references. Furthermore, as stated previously, Duphorne does not exclusively rely on the querying method that Applicants have described. The system includes automatic notification by the email server to the central office upon the arrival of a new email (Col. 4 lines 10-14). Furthermore, the central office may itself contain and maintain the users email server as described in Col. 3 lines 27-34, and Col. 3 line 66- Col. 4 line 20. For these reasons, applicants arguments are not persuasive.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lazaro whose telephone number is 571-272-3986. The examiner can normally be reached on 8:30-5:00 M-F.

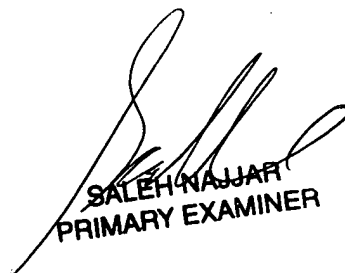
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on 571-272-4006. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



Art Unit: 2155

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Lazaro  
June 22, 2005



SALEH NAJJAR  
PRIMARY EXAMINER